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10/789,004

02/27/2004

Samuel A. Vona JR.

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/789,004 | Applicant(s) VONA, SAMUEL A. | |
| | Examiner MELISSA S. MERCIER | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 and 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 and 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

Receipt of Applicants Remarks and Amended Claims filed on June 11, 2008 is acknowledged. Claims 18, 20-29 remain pending in this application. Applicant has stated in the remarks that claims 18-29 are pending, however, claim 19 is listed as "deleted" and it's the limitation of claim 19 has been incorporated into claim 18. Applicant has indicated in their reply to the 102(b) rejection over Melby the claim has been cancelled. Applicant is therefore requested to correct the claim identifier to cancel in response to this office action.

Claim Objections

Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant has stated in their reply to the 112, 1st paragraph rejection, that starches are genetically modified to increase or decrease the amylopectin or amylose content, therefore, by the recitation of high amylose starch, the fact that it is genetically modified would be an inherent property of the starch and thus claim 21 does not further limit the starch of claim 18.

However, it does appear Applicant is intending to limit the starch to be cationically or nonionically modified and not modified in a generic sense. It is suggested

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Applicant use terminology similar to "wherein the high amylose starch is cationically or nonionically modified".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 20-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is further unclear what applicant is claiming by "stabilizing". After a review of the specification, it appears applicant is claiming amylose-containing starch compounds protect color treated hair from fading. Clarification and Appropriate correction is requested.

Response to Arguments

While the claims are read in light of the specification, limitations from the specification can not in interpreted into the claims. Therefore, it is suggested the claims be amended to recite the definition of what is intended by stabilizing artificial hair color in order to clarify the claim language.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 20-22, 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by National Starch and Chemical Corp (GB 1,285,547).

GB'547 discloses a hair setting composition comprising cationic high amylose containing starch (title). The application of the composition to wet or dampened hair provides a film which can impart desirable properties such as body and smoothness (page 1, lines 16-28). The amylose content is more than 50% by weight of the starch (page 1, lines 51-52). The high amylose starch is present in the amount of 1-6% by weight of the total composition (page 1, lines 47-49). It is additionally disclosed the composition can be utilized as a crème rinse which is applied after the users hair is washed and serves to effectively balance or neutralize the inherent negative charge of the hair (page 2, lines 20-35). The amylose may be from corn (page 2, lines 36-40). Other film forming ingredients may be added (page 2, lines 65-69).

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)

Claims 18, 20-21, 23-25, and 28-29 rejected under 35 U.S.C. 102(b) as being anticipated by Paul et al. (US 6,344,183).

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Paul discloses a hair cosmetic composition comprising nonionically derivatized starches (abstract). The starch is present from 0.5-15% of the composition (column 2, lines 36-38). Suitable starches include high amylose corn starch (column 3, lines 40-44). High amylose is at least about 45% by weight amylose (column 3, lines 47-49), which would reasonably read on claim 20's "about 50% by weight". Film forming agents can be included (column 1, lines 46-47). The formulation may be in the form of lotions and creams (column 8, lines 1-2 and 45-48).

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)

Conclusion

No claims are allowed. **Due to the new grounds of rejection presented in this office action, this action is made Non-Final.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615